

REMARKS

I. Introduction

Claims 1, 2, 5, 6, 8, 9 and 11 to 21 are pending in the present application. In view of the preceding amendments and following remarks, it is respectfully submitted claims 1, 2, 5, 6, 8, 9 and 11 to 21 are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1, 2, 5, 6, 8, 9 and 11 to 21 Under 35 U.S.C. §103(a)

Claims 1, 2, 5, 6, 8, 9 and 11 to 21 were rejected under 35 U.S.C. §103(a) as unpatentable over United States Patent 5,670,237 ("Shultz et al.") in view of United States Patent 5,154,868 ("Heckel et al.") and Great Britain Patent 2,151,277 ("Welburn"). Applicants respectfully submit that the combination of Shultz et al., Heckel et al. and Welburn does not render obvious claims 1, 2, 5, 6, 8, 9 and 11 to 21 for the following reasons.

The Office Action admits that Shultz et al. fail to provide a covering which is made of an elastomer material. The Office Action further admits that Shultz et al. fail to disclose that the indentation have a depth of 0.02 mm to 0.2 mm, a width of 0.2 mm to 2.5 mm and a length of 5 mm to 50 mm or have indentations having a depth of 0.025 mm to 0.05 mm, a width of 0.4 mm to 1.3 mm and a length of 6mm to 40 mm. The Office Action still further admits that Shultz et al. fail to disclose a configuration wherein at least one of the lateral border edges of the indentation at at least one location widens, to the outside, or narrows, to the inside.

Claim 1 relates to a floor covering comprising: an elastomer material having a relief-type patterned surface, wherein the surface (2) is provided with irregularly distributed indentions (3), which have an elongated shape, which partially contact or intersect each other, and which have a depth (T) of 0.02 mm to 0.2 mm, at a width (B) of 0.2 mm to 2.5 mm and a length (L) of 5 mm to 50 mm wherein at least one end (6) of the indentation (3) is configured so as to run to a point. Claim 1 also recites that the indentations are essentially straight and wherein the relief-type patterned surface minimizes roll resistance. Claim 1 has been amended such that each indentation has a different shape from every other indentation. Support for the amendment to

claim 1 is found, for example, on page 2, line 30 to page 3, line 1 and Figure 1.

Shultz et al. allegedly provide a method for making a surface covering product and products resulting from said method. Title. As provided in Shultz et al. Figure 5, a design is provided with indentations which are placed on a surface. The Shultz et al. reference does not disclose any configuration where the indentations in the surface are essentially straight, wherein each of the indentations is different in shape from each other indentation. Additionally, Shultz et al. do not provide a pattern or configuration which minimizes roll resistance. Applicants respectfully submit that the configuration of the current invention presents a system which provides advantages to rolling resistance as presented in the table beginning on page 4. The Shultz et al. reference is silent with regards to any type of configuration which minimizes this resistance. The Shultz et al. reference merely provides a indentations throughout a component. See Fig. 5. The Shultz et al. reference does not disclose or suggest that these indentation are configured to come to a point.

The addition of the Heckel et al. reference does not cure the critical defects of the Shultz et al. reference. The Heckel et al. reference allegedly relates to a method of manufacturing a randomly patterned floor covering from a preform of rubber. The Heckel et al. reference does not cure the critical defects of the Schultz et al. reference as the Heckel et al. reference does not provide a pattern or configuration which minimizes roll resistance. The Heckel et al. reference is silent regarding any configuration which relates to roll resistance or to minimization of this resistance. The Heckel et al. reference is further deficient in not disclosing or suggesting straight indentations which come to a point, wherein each of the indentations is different in shape from each other indentation.

The addition of the third level Welburn reference does not cure the defects of the Shultz et al. and Heckel et al. references. The Welburn reference allegedly relates to non-slip floor. Welburn discloses indentations which are straight in configuration, but do not come to a point at the ends. The Welburn reference further does not disclose or suggest any configuration wherein each indentation is different in configuration from each other

configuration. All of the references are deficient in not disclosing that each of the straight indentations are different in configuration from each other and end in a point.

In rejecting a claim under 35 U.S.C. §103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 23 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claim of limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

It is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Final Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a 35 U.S.C. §103 rejection. It is respectfully submitted that the Final Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the reference relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under §103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done....

Instead, the examiner relies on hindsight in reaching his obviousness determination.... One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art preferences in order to establish a prima facie obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art....

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if they'd be called evidence) that one of ordinary skill... would have been motivated to make the modifications...necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944(citations omitted; italics in original).

This is exactly the case here since it is believed and respectfully submitted that the present Final Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction, and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met there by. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept"--which is not the case here--there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claim subject matter to "make the combination in the matter claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the matter claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims... under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). Again, it is believed that there have been no such findings.

Claims 8 and 9 have been cancelled, without prejudice. Claims 2, 5, 6 and 11 to 21 ultimately depend from claim 1 and therefore include the features of amended claim 1. Applicants respectfully submit that claims 2, 5, 6 and 11 to 21 are patentable for at least the reasons presented above in relation to amended claim 1.

III. Conclusion

It is therefore respectfully submitted that the pending claims are allowable. All issues raised by the Examiner have been addressed, and an early and favorable action on the merits is solicited.

Respectfully submitted,

KENYON & KENYON

Dated: January 20, 2005

By: 

Richard M. Rosati
Registration Number 31,792

One Broadway
New York, New York 10004
(212) 425-7200
Customer Number 26646